

## REMARKS

Claims 1 through 7 are pending in this Application. Claims 1 and 6 have been amended to address formalistic issues raised by the Examiner. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

### **Clarification of record.**

Upon review of the June 28, 2004 Office Action, it was noted that the Examiner did not acknowledge the claim for foreign priority pursuant to 35 U.S.C. § 119 and receipt of the certified copy of the priority document filed on May 5, 2002. Accordingly, the Examiner is requested to clarify the record by acknowledging the claim for foreign priority pursuant to 35 U.S.C. § 119 and receipt of the certified copy of the priority document.

### **Information Disclosure Statement.**

The Examiner asserted that the Japanese Document 63-248734 was not considered because an English language translation or abstract was not provided and the relevance not explained.

Applicants note that this reference is discussed in the first full paragraph on page 3 of the written description of the specification and a copy of this reference was again submitted for the Examiner's attention in an Information Disclosure Statement (IDS) filed on August 11, 2004, together with an English language abstract. Accordingly, the Examiner is requested to acknowledge receipt of the IDS and to provide an appropriately initialed copy of Form PTO-1449 indicating consideration of that Japanese Document 63-248734.

**AMENDMENTS TO THE DRAWINGS**

The attached sheets of drawings (Exhibit A) include changes to Figs. 2a, 2b and 4, which changes include adding the legend "PRIOR ART".

**Drawings.**

The Examiner asserted that Figs. 2a, 2b and 4 should be designated by an appropriate legend, such as “PRIOR ART.” As previously noted, the attached Replacement Sheets (Exhibit A) include the legend “PRIOR ART” in each of Figs. 2a, 2b and 4, as suggested by the Examiner. Accordingly, withdrawal of the drawing objection is solicited.

**Claims 6 and 7 were rejected under the second paragraph of 35 U.S.C. § 112.**

In the statement of the rejection the Examiner asserted a lack of antecedent basis for “soot perform” and “the diameter”. This rejection is traversed.

Firstly, the mere assertion of a lack of literal antecedent basis does not automatically trigger a rejection under the second paragraph of 35 U.S.C. § 112, which is a legal issue. *Bose Corporation v. JBL, Inc.*, 274 F.3d 1354, 61 USPQ2d 1216 (Fed. Cir. 2001).

At any rate, in order to expedite prosecution, claims 1 and 6 have been amended to address the issues raised by the Examiner, thereby overcoming the stated bases for the imposed rejection. Clearly, one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicants, therefore, submit that the imposed rejection of claims 6 and 7 under the second paragraph of 35 U.S.C. § 112 is not legally viable and, hence, solicit withdrawal thereof.

**Claims 1 through 3 and 5 through 7 were rejected under 35 USC §103 for obviousness predicated upon Nouchi et al. or Gubb et al. in view of Powers, Terasawa et al., Watanabe et al. and Oyamada et al.**

In the statement of the rejection the Examiner admitted that none of the primary references to Nouchi et al. or Grubb et al. discloses the concept of forming soot performs having a structure similar to the final product. Nevertheless, the Examiner concluded that one having ordinary skill in the art would have been motivated to fabricate soot performs for the fibers disclosed by each of Nouchi et al. and Grubb et al. employing the dual burner technique of the secondary references. The Examiner further concluded that one having ordinary skill in the art would have been motivated to form the soot perform layers with the same diameter ratios as in the final product.

This rejection is traversed. Specifically, there is a fundamental difference between the claimed method and the methods of the primary references which undermine the obviousness conclusion reached by the Examiner.

In accordance with the present invention, a soot layer is formed on an outer periphery of the glass rod. In order to achieve a high deposition rate and a high yield rate of the glass particles, a second soot layer is formed on an outer periphery of the first soot layer which is formed on the outer periphery of the glass rod. This sequence of manipulative steps and resulting structure are neither disclosed nor suggested by the applied prior art. Indeed, the applied references relate to methods which involve forming a first soot layer employing a second burner on an outer periphery of a soot formed by a first burner, or a technique for forming **only one** soot layer on an outer periphery of the glass rod. It is not apparent wherein the applied prior art discloses or suggests a method comprising forming a soot layer on an outer periphery of a glass rod, and then forming a second soot layer on an outer periphery of the first soot layer formed on the outer periphery of the glass rod.

It should, therefore, be apparent that the present invention is clearly distinguishable over the applied references by providing a base material or a starting rod that is used to form the soot layers as a base, and in the conditions for forming the soot layers. There is no apparent factual basis upon which to predicate the conclusion that one having ordinary skill in the art would somehow have been realistically led to modify the applied prior art or to somehow entwine the applied references to arrive at the claimed invention, absent improper reliance upon Applicant's disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Further, Applicants separately argue the patentability of each of claims 5 and 6. Specifically, the Examiner's reliance upon drawings is clearly improper, because drawings are not drawn to scale. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986); *Hockerson-Halberstadt Inc. v. Avia Group Int'l.*, 222 F.3d 951, 55 USPQ2d 1487 (Fed. Cir. 2000).

Moreover, the Examiner did not discharge the initial burden of specifically identifying wherein any of the applied references discloses or suggests that the angle specified in claim 5, or the distances specified in claim 6, are in fact art-recognized result effective variables. Until such time as the Examiner can factually establish that such parameters are art-recognized result effective variables, it is legally erroneous to conclude that one having ordinary skill in the art would somehow have been lured to optimize phantom variables. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *In re Yates*, 663 F.2d 1054, 211 USPQ 1149 (CCPA 1981); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Based upon the foregoing it should be apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-*

*Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, a *prima facie* basis to deny patentability to the claimed invention has not been established.

Applicants, therefore, submit that the imposed rejection of claims 1 through 3 and 5 through 7 under 35 U.S.C. § 103 for obviousness predicated upon Nouchi et al. or Grubb et al. in view of Powers, Terasawa et al., Watanabe et al. and Oyamada et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 3 and 4 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Nouchi et al. or Grubb et al. in view of Powers, Terasawa, Watanabe, or Oyamada and Cain et al.**

This rejection is traversed. Claims 3 and 4 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness predicated upon Nouchi et al. or Grubb et al. in view of Powers, Terasawa et al., Watanabe and Oyamada et al. And the additional reference to Cain et al. does not cure the previously argued deficiencies.

Moreover, Applicants separately argue the patentability of claim 4. Specifically, the Examiner did not point out wherein any of the applied references discloses or suggests the ratio of the diameter openings of the burners as specified in claim 4. Indeed, the Examiner did not establish, as a factual matter, that the ratio of the diameter openings of the burners is an art-recognized result defective variable. Accordingly, it is legally erroneous to conclude that one having ordinary skill in the art would have been realistically motivated to manipulate such diameter openings. *In re Rijckaert, supra; In re Yates, supra; In re Antonie, supra.*

Applicants, therefore, submit that the imposed rejection of claims 3 and 4 under 35 U.S.C. § 103 for obviousness predicated upon Nouchi et al. or Grubb et al. in view of Powers, Terasawa et al., Watanabe et al., or Oyamada et al. and Cain et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

It should, therefore, be apparent that the imposed objections and rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Arthur J. Steiner  
Registration No. 26,106

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
202.756.8000 AJS:bjs:ntb/lrd  
Facsimile: 202.756.8087  
**Date: September 27, 2004**